



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/574,172

10/25/2006

Rainer Uecker

2003P13562WOUS

4104

22116

7590

12/03/2008

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

FAN, HUA

ART UNIT

PAPER NUMBER

2456

MAIL DATE

DELIVERY MODE

12/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/574,172 | Applicant(s) UECKER, RAINER | |
| | Examiner HUA FAN | Art Unit 2456 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 21 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2008 has been entered. Claims 16, 21 and 23-30 are pending.

Response to Arguments

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 16, 21, and 24-30 are rejected under 35 U.S.C. 103(a) as unpatentable over Etsuo (WO 01/20855) in view of Rollins (US patent 6434601).

As to claim 16, Etsuo discloses a method for transmitting messages (figure 1 and 2, “mail”) in a network (figure 1 and 2, component 100) via data terminals connected thereto (figure 1 and 2, components 200A, 200B, 200C, 200D, 300), comprising:

sending a message to be relayed from a sender data terminal (figure 1 and 2, component 200A, page 24, paragraph 3, “during sending behavior, the user of client 200A...inputs information about e-mail MAILB addressed to client 200B using input unit) to a first mail

Art Unit: 2456

processing device assigned to the sender data terminal (figure 1 and 2, component 200A; page 24, paragraph 5, “the control unit 203AS of client 200A attaches A001...as the identifier to body BOA...”; page 19, paragraph 3, “client 200A is equipped with a duplicate transmission prevention function which prevents duplicate transmission of the same e-mail”; page 10, paragraph 1, “control unit 203A...cancels sending the new e-mail if the same body included in the new e-mail is stored in the memory means”);

assigning a unique identifier to the message) that indicates that a message to be relayed is on the sender data terminal (figure 9 and 5(a), “Identifier – A0001”, “Sender Address = A”; page 21, paragraph 2-3, “PA”, “pair of body and identifier...forwarded body and an identifier”; page 26, paragraph 6), or in the first mail processing device (page 24, paragraph 5, “the control unit 203AS of client 200A attaches A0001...as the identifier to body BOA...”; page 26, paragraph 6, “identifier (=A0001)...sender address (=A)), wherein the identifier comprises a plurality of sub-identifiers, each of which is assigned to at least one message element contained in a relayed message (page 21, paragraph 2-3, “pair of body and identifier...forwarded body and identifier”).

evaluating in the second mail processing device the identifier sent by the first mail processing device, the evaluating configured to process each sub-identifier relative to data present in the second mail processing device indicative of respective message elements previously relayed to the recipient address data terminal (abstract; page 9, paragraph 4 – page 10, paragraph 1; page 20, paragraph 2, “mail server 300 has a duplicate receipt notification prevention function which avoids sending a receipt notice about forwarded email which is essentially the same as an e-mail about which the receipt notice has already been sent to the

Art Unit: 2456

client”; page 35, paragraph 2- page 36, paragraph 4, for a forward email (originated from 200A, and forwarded by 200B, the mail server will process each sub-identifiers);

Etsuo discloses a second mail processing device assigned to a recipient address data terminal (page 10, lines 1-14, “203A-203D (client control means) cancels sending the new email if the same body included in the new e-mail is stored in the memory mean...mail server...determines, when it receives an e-mail including a body and an identifier attached tot eh body from the above-mentioned client, whether or not the said identifier matches any of the identifiers relating to other e-mails received in the past, and has a control means which sends a receipt notice to the addressee of said e-mail if the result of the above-mentioned decision is a no-match and does not send a receipt notice...if...is a match" where "client control means 203A-203D of clients 200A-200D" is equivalent to the “first mail processing device”; the “control unit 301” of the “mail server" is equivalent to the “second mail processing device” assigned to “a recipient address data terminal” (the addresses of said e-mail that the control unit 301 of the mail server determines to send or not to send the receipt notice to); the second mail processing device (mail server)’s evaluation result indicates transmitting the message elements, evaluated as not previously relayed to the recipient address data terminal; and blocking message elements evaluated as previously relayed to the recipient address data terminal (abstract; page 9, paragraph 4 – page 10, paragraph 1); the first mail processing device (client control means)’s evaluation result to transmitting or blocking a transmission of respective ones of the message elements to the second mailing processing device in response to the client’s evaluation result (abstract; page 9, paragraph 4 – page 10, paragraph 1); and relaying to the recipient address data terminal respective message elements transmitted from the first mail processing device to the second mail

Art Unit: 2456

processing device (page 10, paragraph 1, “sends a receipt notice to the addressee”; page 7, paragraph 3, client accesses to mail server upon receiving the notice).

However, Etsuo does not expressly disclose sending a test message from the first mail processing device to the second mail processing device; sending an evaluation-result message from the second mail processing device to the first mail processing device, first mail processing device transmitting or blocking message in response to the evaluation-result message. Rollins discloses before sending out an email, sending out a test message from first mail processing device to second mail processing device (figure 1, component S18, “ping server to test for existence” and S30, “Does addresses exist on server”; col. 4, lines 33-40, 43-48); sending an evaluation-result message from the second mail processing device to the first mail processing device (figure 1, component S18-S20, response to “Ping server to test for existence”; S30-S34, response to “Does addressee exist on server?”; col. 4, lines 39-43, 47-50); and the first mail processing device transmitting or blocking message in response to the evaluation-result message (figure 1, components S18, S20, S24, S26, S30, S34 and S34; see col. 4, lines 54-59; col. 5, lines 2-4 for the case of "transmitting"; see col. 4, lines 48-54 for the case of "blocking").

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the teachings disclosed by Etsuo with the teachings disclosed by Rollins regarding before sending out an email, sending out a test message from first mail processing device to second mail processing device; sending an evaluation-result message from the second mail processing device to the first mail processing device; and the first mail processing device transmitting or blocking message in response to the evaluation-result message. The suggestion/motivation of the combination would have been to prevent the delivery of an e-mail

Art Unit: 2456

message having an incorrect user name, server name, or a misspelling in either or both in the addressee's Internet e-mail address and calls the addressing error to the sender's attention, where it may be corrected before the message is sent, thereby eliminating the potential of losing hours, perhaps days, before the addressing error is discovered (Rollins, col. 3, lines 12-21).

As to claim 21, Etsuo- Rollins discloses the method according to claim 17, wherein the identifier is evaluated on a mail server in the network (Etsuo, page 10, paragraph 1; figure 1).

As to claim 24, Etsuo- Rollins discloses the method according to claim 17, wherein the identifier and/or the relevant sub-identifier indicates an e-mail address of an original sender if this differs from the e-mail address of the sender, and/or the contents of the message or of the respective message element (Etsuo, page 33, paragraph 4-5, "A0001" where "A" indicates address of original e-mail sender, "BOA" indicates body of original sender; "B0001" where B indicates address of the forwarding email sender, "BOB" indicates the forwarding body. Also see figure 5, "Sender address = A", original sender).

As to claim 25, Etsuo- Rollins discloses the method according to claim 16, wherein there is a data terminal for executing the method (Etsuo, claims 1-2 and 7; page 10, paragraph 1, control units 203A-203D of clients 200A-200D) and having a mail processing device that is designed such that an identifier for a message based on data present concerning the entry of messages at an address data terminal from the past is evaluated in an evaluation unit (Etsuo, claims 1-2 and 7; page 10, paragraph 1, "control unit 301" of mail server), and such that, based on the evaluation result, transmission of a message to the address data terminal is triggered or blocked (Etsuo, claims 1-2 and 7; page 10, paragraph 1).

Art Unit: 2456

As to claim 26, Etsuo- Rollins discloses the method according to claim 25, wherein the mail-processing device forms part of a mail server (Etsuo, claim 1; page 10, paragraph 1, "control unit 301", the mail processing device, is part of the mail server), which is integrated in the data terminal (Etsuo, mail server can be used as data terminal as well since it is able to generating and receiving emails, page 22, paragraph 4; also see page 42, paragraph 3, the method can be implemented on an integrated single computer).

As to claim 27, Etsuo- Rollins discloses the method according to claim 25, wherein a memory unit for storing data concerning the entry of messages at a different data terminal (Etsuo, mail server 300, page 22, paragraph 4 – page 23, paragraph 1; page 10, paragraph 1, each client's control unit (for example 200A) has the data stored in its own memory unit (205A in this case)).

Claim 28 is a network claim corresponding to the method claim 1. Therefore it has been analyzed and rejected based upon the method claim.

As to claim 29, see similar rejection to claim 26.

As to claim 30, Etsuo- Rollins discloses the network according to claim 29, further comprising a memory unit for storing previously relayed message elements (Etsuo, page 35, paragraph 4, "control unit 301 holds forwarding body BO of forwarding e-mail MAILab in the memory unit 303"; page 10, paragraph 1, "if the same body included in the new e-mail is stored in the above-mentioned memory means...whether or not the said identifier matches any of the identifiers relating to the e-mails received in the past").

5. Claim 23 is rejected under 35 U.S.C. 103(a) as unpatentable over Etsuo, in view of Rollins, as applied to claim 16 above, and further in view of Yoshihiro (JP 11232188).

Art Unit: 2456

As to claim 23, Etsuo-Rollins does not expressly disclose a notification of the blocked transmission is forwarded to the sender and/or recipient if the transmission is blocked on the basis of the evaluation result. Yoshihiro discloses a duplicate notice mail is transmitted to the originator of the received electronic mail when it blocks the transmission of the email (abstract).

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the method disclosed by Etsuo-Rollins with the method disclosed by Yoshihiro regarding a duplicate notice mail is transmitted to the originator of the received electronic mail when it blocks the transmission of the email. The suggestion/motivation of the combination would have been to inform the originator that the predetermined title and predetermined message of the received E-mail are the same (Yoshihiro, [0020]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUA FAN whose telephone number is (571)270-5311. The examiner can normally be reached on M-F 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2456

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. F./

Examiner, Art Unit 2456

/Bunjob Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2456